APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,113	03/01/2002	Brett Howard	12315-US	7220

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EXAMINER
LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/085,113	HOWARD, BRETT
	Examiner	Art Unit	
	Christian La Forgia	2131	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>01 July 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/29/02</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   The amendment of 24 January 2006 has been noted and made of record.

2.   Claims 1-15 have been presented for examination.

Response to Arguments

3.   Applicant's arguments filed 24 January 2006 have been fully considered but they are not

persuasive.

4.   In response to the Applicant's argument that *Sasaki* does not disclose verifying the target

identifier before the embedded system is enabled to install the digital file on the embedded

system, the Examiner respectfully disagrees. According to **Microsoft Computer Dictionary 5th**

Edition, to install means to set in place and prepare for operation. Based on that definition,

Sasaki discloses placing the file on the system and preparing for operation by the user as cited

below. Furthermore, http://www.pcwebopaedia.com/TERM/l/load.html defines load as to

install. Based on the web definition, *Sasaki* discloses verifying the identifier prior to installation

at the user system as cited below.

5.   With respect to the Applicant's allegation that *Sasaki* does not teach installing as

changing executable applications on a system, the Examiner kindly directs the Applicant's

attention to MPEP § 2131, in particular the discussion of *ipsissimis verbis*. *Ipsissimis verbis*

states that the elements of the invention must be arranged as required by the claim regardless of

the identity of terminology. In other words, the fact that *Sasaki* does not use the same

terminology as the Applicant, yet teaches the elements of the claim language is not enough to

distinguish the instant application over the prior art.

6.   Furthermore, the Applicant suggests that the claims fail to be interpreted in light of the specification with regards to the Applicant's use of the word install. The Examiner first would like to point out that where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. See MPEP § 608.01(o).

Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "install" repeated through many of the claims is used to mean "change executable applications on a system." The accepted meaning of install as it relates to computers is "to set in place and prepare for operation" taken from the **Microsoft Computer Dictionary, 5th Edition**. In addition to using the term install in a manner contrary to its ordinary meaning, the Applicant fails to meet the requirements of redefining a term as set forth in the MPEP § 2106. In order to define/redefine a term, the Applicant must do so "with reasonable clarity, deliberateness, and precision" and must " set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning. The Applicant fails to clearly, deliberately and precisely define the term install. Furthermore, the Applicant fails to set out the uncommon definition in the instant application's disclosure.

7.   In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, such as the target identifier corresponding to the embedded system, are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9. See further rejections that follow.

Drawings

10. The drawings were received on 01 July 2002. These drawings are accepted.

Claim Rejections

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-3, 7, 11, 12, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0077988 to Sasaki et al, hereinafter Sasaki.

13. As per claims 1 and 7, Sasaki discloses a method of providing digital data from a source system to an embedded system in a secure manner, comprising the steps of:

combining the digital file with header information including a target identifier corresponding to the embedded system (Figures 4 [blocks 137, 139], 5b [block 162], paragraphs [0038]-[0040], [0042]);

providing the combined digital file with header information to the embedded system (Figures 5b [block 166], 7 [blocks 190, 198], paragraphs [0042], [0043], [0045]); and

verifying the target identifier before the embedded system is enabled to load install said

digital file on the embedded system (Figures 6 [blocks 172, 182], 7 [block 194], 8b [block 222],

paragraph [0044], [0045], [0047]).

14.   Regarding claim 2, Sasaki teaches wherein the target identifier is a text name

corresponding to an end user of an Internet based service (paragraph [0042], i.e. serial number

assigned to user).

15.   Regarding claim 3, Sasaki teaches wherein said target identifier includes a revision level

respecting said digital file (Figure 4 [block 138], paragraph [0038], i.e. instructions for

controlling the playback, such as playback settings and restrictions on number of times content

can be played).

16.   Regarding claim 11, Sasaki teaches for use in conducting transactions on the Internet

(paragraph [0031]).

17.   With regards to claim 12, Sasaki discloses wherein said transactions include the purchase

and download of software (Figure 5b [block 160], paragraph [0042]).

18.   With regards to claim 15, Sasaki teaches wherein said network nodes include wireless

telephones (Figure 3a, paragraphs [0006], [0013], [0035]).

19.   Claims 4-6, 8-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sasaki in view of U.S. Patent No. 6,401,206 to Khan et al., hereinafter Khan.

20.   As per claim 4, Sasaki teaches a method of providing digital data from a source system to

an embedded system in a secure manner comprising the steps of:

combining the digital file with header information including a target identifier

corresponding to the embedded system (Figures 4 [blocks 137, 139], 5b [block 162], paragraphs

[0038]-[0040], [0042]);

providing the combined digital file with header information to the embedded system

(Figures 5b [block 166], 7 [blocks 190, 198], paragraphs [0042], [0043], [0045]); and

verifying the digital signature and the target identifier before the embedded system is

enabled to install the digital file on the embedded system (Figures 6 [blocks 172, 182], 7 [block

194], 8b [block 222], paragraph [0044], [0045], [0047]).

21.   Sasaki does not teach signing the combined digital data with header information with a

digital signature corresponding to the source system the digital signature being added to the

header information.

22.   Khan discloses using digital signatures being used to authenticate digital document and

the origin source (column 3, line 66 to column 4, line 9).

23.   Both Sasaki and Khan are related to binding identities to secure electronic data to be

transmitted over a network.

24.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to sign the combined digital data with header information with a digital signature

corresponding to the source system the digital signature being added to the header information,

since Khan states at column 4, lines 4-9 that such a modification can be used to authenticate the

integrity and identity of an electronic document, as well as for non-repudiation of the document's

origination source.

25.   Regarding claim 5, Khan teaches wherein the step of signing the combined digital data

with header information uses a private cryptographic key associated with the source system to

generate the digital signature (column 5, line 57 to column 6, line 6).

26.   With regards to claim 6, Khan discloses wherein the step of verifying the digital signature

uses a public key corresponding to the private cryptographic key (column 6, lines 14-21).

27.   Regarding claim 8, Sasaki does not teach means to provide a digital signature for use in

verifying the files before installing the files on the embedded system.

28.   Khan discloses means to provide a digital signature for use in verifying the files before

installing the files on the embedded system (column 3, line 66 to column 4, line 9, column 5, line

57 to column 6, line 6).

29.   Both Sasaki and Khan are related to binding identities to secure electronic data to be

transmitted over a network.

30.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide a digital signature for use in verifying the files before installing the files on

the embedded system, since Khan states at column 4, lines 4-9 that such a modification can be

used to authenticate the integrity and identity of an electronic document, as well as for non-

repudiation of the document's origination source.

31.   With regards to claim 9, Sasaki does not disclose public keying infrastructure for

distributing public keying information to said embedded system.

32.   Khan teaches public keying infrastructure for distributing public keying information to

said embedded system (column 6, lines 7-21).

33.   Both Sasaki and Khan are related to binding identities to secure electronic data to be

transmitted over a network.

34.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to distribute the public key information to the embedded system, since Khan states at

column 6, lines 11-21 that such a modification can be used to authenticate and verify the

integrity and identity of an electronic document.

35.   Concerning claim 10, Khan discloses having software for performing signature

generation and verification (column 5, line 57 to column 6, line 6).

36.   With regards to claim 13, Sasaki does not disclose wherein said transactions include

online banking.

37.   Khan teaches wherein said transactions include online banking (column 6, lines 37-48).

38.   Both Sasaki and Khan are related to binding identities to secure electronic data to be

transmitted over a network.

39.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide secure transactions for online banking, since Khan states at column 6, lines

11-21 that such a modification can be used to authenticate and verify the integrity and identity of

a transactions.

40.   Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view

of U.S. Patent No. 6,169,976 to Colosso, hereinafter Colosso.

41.   With regards to claim 14, Sasaki does not teach wherein said transactions include the

installation of software revisions in network nodes.

42.   Colosso discloses wherein said transactions include the installation of software revisions

in network nodes (column 2, lines 52-60).

43.   Both Sasaki and Colosso are related to software control using licenses.

44.   It would have been obvious to one of ordinary skill in the art at the time the invention

was made to provide secure transactions for online banking, since Colosso states at column 2,

lines 7-31 that such a modification can be used to regulate the reproduction of licensed products.

Conclusion

45.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

46.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

47.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792.

The examiner can normally be reached on Monday thru Thursday 7-5.

48.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

49.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia
Patent Examiner
Art Unit 2131

clf

CHRISTOPHER REVAK
PRIMARY EXAMINER